

**REMARKS**

**Information Disclosure Statement**

Applicants have submitted a number of references that were not considered by the Examiner because of various reasons, that is, some of the references cited were missing dates and/or translations. Applicants have made the necessary corrections to those previously submitted references that were not considered by the Examiner and respectfully request that the Examiner reconsider these references.

**Specification**

The Examiner has objected to the disclosure because of the following informalities: The first sentence of the specification should be amended to provide the most current status of the related application. Applicants have added the most current status of U.S. Application Serial No. 10/472,295 filed September 18, 2003. That is, Application Serial No. 10/472,295 filed September 18, 2003 issued on September 5, 2006.

**Claim Rejections**

**35 USC 102(b)**

The Examiner has rejected claims 1 and 2 under 35 U.S.C. 102 (b), as being anticipated by Yates et al., (U.S. HO 001,904). Applicants have amended

independent claims 1 and 2 so as to better distinguish applicant's present disclosure from the above cited prior art reference. In particular, applicants have amended these claims to further include, an electrical feed path for the transfer of electrosurgical energy to the jaw members. "[P]roviding a pair of opposing channels, said channels extending from a proximal end of said shaft to said distal end of said shaft, said channels each having an electrical conductor disposed therein, each of said electrical conductors having a first end being connected to said electrosurgical energy source and a second end connected to said jaw members..." This type of arrangement is not present in Yates. In Yates, "sheath 38 moves over the camming surface 27 of the electrically conductive anvil which acts as the return electrode," see column 8 lines 10-14 of the Yates disclosure. Also, lines 22-25 of the same column disclose, "[t]he clamping trigger 12 is squeezed to cause the sheath 38 to move over the camming surface 27 and thereby close jaws 32, 34 and simultaneously close the electrical circuit as described above." This can further be evidenced in figs. 4 and 5 of the same disclosure.

In order to obviate a 102(b) rejection, applicant can amend the rejected claims to be patentably distinguishable from the cited prior art reference. Because applicants' electrical feed path, in claims 1 and 2 of the present disclosure, is patentably distinguishable from the above cited prior art reference, namely, Yates, these claims and any claims that depend therefrom should be in condition for

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allowance.

For the same reasons, new claim 3 should also be in condition for allowance.

**35 USC §102(f)**

The Examiner has also rejected claims 1 and 2 under 35 U.S.C. §102 (f) because, as averred by the Examiner, applicant did not invent the claimed subject matter. This rejection should now be considered moot in light of the amendments made to these claims. The cited prior art, U.S. Patent Application No. 10/849,432, does not claim the same subject matter as claims 1 and 2 and as such these claims should now be in condition for allowance.

For the same reasons, new claim 3 should also be in condition for allowance.

**35 USC §103**

With respect to the Examiner's rejection of claims 1 and 2 under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,277,117 to Tetzlaff, it is respectfully submitted that the this reference qualifies as art under 35 USC §102(e) and is owned by a common Assignee of record, namely, Sherwood Services AG, and is therefore not properly citable as prior art against the present application.

More particularly and as per MPEP § 706.02(I), the present application was filed after November 29, 1999 and on information and belief the claims of the present application and the cited publication relate to subject matter which were at

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the time the invention was made, owned by the same corporation and under an obligation of assignment to the same corporation, namely, Sherwood Services AG. In accordance with MPEP §706.02(I), the above statement is sufficient evidence to show common ownership at the time the invention was made:

*Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. MPEP §702(I)*

In view of the foregoing, it is respectfully submitted that the Tetzlaff publication is disqualified as prior art against claims 1-2 of the present invention. New claim 3 is also believed to be allowable for at least the same reasons as specified above.

### **Double Patenting**

Claims 1-2 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over the pending claims of co-pending U.S. Patent Application No. 10/849,432, in view of the teaching of Eggers et al. (5,484,436).

Applicants have included the necessary terminal disclaimer to obviate the provisional nonstatutory double patenting rejection over the pending patent

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application which disclaims the terminal portion of the statutory term of any patent granted on the present application which would extend beyond the expiration date of the full statutory term of U.S. Patent Application No.: 10/849,432. The Assignee of the instant application namely, Sherwood Services AG, owns 100% interest in the present application and U.S. Patent Application No.: 10/849,432.

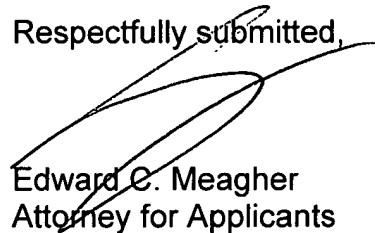
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**CONCLUSION**

It is respectfully submitted that all of the claims now pending in this application, namely Claims 1, 2, and 3 are now in condition for allowance. Accordingly, early and favorable consideration of this application is respectfully requested. It is respectfully submitted that none of the references of record considered individually or in combination anticipate, disclose or suggest the claims as presently amended. Accordingly, withdrawal of the rejections is respectfully requested.

In view of the foregoing amendments and remarks, reconsideration of the rejections and objections and allowance of the claims are earnestly solicited.

Respectfully submitted,



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